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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,659	09/05/2003	Tetsuo Shibamura	09792909-5708	8320

26263 7590 11/19/2004

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EXAMINER

HUANG, EVELYN MEI

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,659

Applicant(s)

SHIBANUMA ET AL.

Examiner

Evelyn Huang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 13, 14 are pending. Claims 1-12, 16-19 have been canceled according to the amendment filed on 9-5-2003.

Election/Restrictions

2. Newly submitted claim 13 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The newly submitted claim 13 is directed to a device comprising the compound of original claim 13, classified in class 252, subclass 301.16.

In the previous office action, the examination was based on claims 13 and 14 being compound claims (classified in class 546, subclass 88), although they are not clearly written, and subjected to 112 second paragraph rejection. The instant claim 14, although dependent on the newly submitted device claim 13, is still directed to a compound and is therefore clearly a compound claim (and would be subjected to 112 second paragraph rejection for improperly dependent on the device claim 13 if claim 13 were not withdrawn from consideration).

The compound and the device have acquired a separate status in the art as shown by their different classification. Furthermore, the compound has use other than being part of the instant EL device, such as inhibition of the growth of microorganisms (Juda, 3951833). Since the search is not co-extensive and is burdensome, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 directed to a device comprising the compound is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

It is recommended that claim 13 be amended back to the compound claim.

Claim Rejections - 35 USC § 112

3. The rejection for Claims 13, 14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendment.

Claim Rejections - 35 USC § 112

4. If claim 13 were to be amended back to the compound claim, the rejection for Claim 13 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement would be maintained for reasons of record. Although examples of aryl and substituted aryl are described, a full definition of 'aryl' and the substituents on the aryl are not found in the specification.

Claim Rejections - 35 USC § 102

5. If claim 13 were to be amended back to the compound claim, the rejection for Claim 13 under 35 U.S.C. 102(b) as being anticipated by Sugihara (Analytical Sciences, 1993, 9: 593-597, PTO-1449) would be maintained for reasons of record.

6. If claim 13 were to be amended back to the compound claim, the rejection for Claim 13 under 35 U.S.C. 102(b) as being anticipated by Dietrich-Buchecker (Tetrahedron Letters, 1986, 17(20): 2257-2260, PTO-1449) would be maintained for reasons of record.

Claim Rejections - 35 USC § 103

7. If claim 13 were to be amended back to the compound claim, the rejection for Claims 13, 14 under 35 U.S.C. 103(a) as being unpatentable over Sugihara (Analytical Sciences, 1993, 9: 593-597, PTO-1449) in view of Daniel (4853090) would be maintained for reasons of record.

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Double Patenting

8. If claim 13 were to be amended back to the compound claim, the provisional rejection for Claims 13, 14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 23 of copending Application No. 09/704968 would be maintained for reasons of record.

Conclusion

9. No claims are allowed.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 571-272-0686. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Evelyn Huang

Primary Examiner

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